

REMARKS

In the Final Office Action¹, the Examiner rejected claims 1-5, 7, 8, 10-30, and 62 under 35 U.S.C. § 101; and rejected claims 1-21, 23-52, 30-52, and 57-65 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,003,011 to Sarin et al. ("Sarin") in view of the article entitled "ProjectDash Drives Consistency in Communicating Project Status Online using Innovative Graphical Project Dashboard" ("ProjectDash").

By this Amendment, Applicant proposes to amend claims 1-3, 10, 11, 24, 25, 28, 31-44, 49, 50, and 57-65 to more appropriately define the invention, and to cancel claim 30, without prejudice or disclaimer. Applicant also proposes to amend claims 32 and 33 to correct typographical errors.

In view of the foregoing proposed amendments and the following remarks, Applicant respectfully traverses the rejections and requests reconsideration and allowance of the pending claims.

I. Examiner Interview

Applicant thanks Examiner Loftis for agreeing to reissue the Final Office Action in view of the need to address new dependent claims added in an Amendment filed November 19, 2008, and to restart time period for response. Applicant agrees with the substance of the Interview Summary mailed with the Final Office Action.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

II. Rejection of Claims 1-5, 7, 8, 10-30, and 62 under 35 U.S.C. § 101

Applicant respectfully traverses the rejection of claims 1-5, 7, 8, 10-30, and 62 under 35 U.S.C. § 101. Claims 1-5, 7, 8, 10-30, and 62 are clearly directed to statutory subject matter. However, solely to facilitate prosecution, Applicant proposes to amend independent claim 1. Applicant submits that independent claim 1, as proposed to be amended, as well as dependent claims 2-5, 7, 8, 10-29, and 62 dependent therefrom, clearly meets the requirements of 35 U.S.C. § 101. Claim 30 is cancelled, rendering its rejection moot. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 101.

III. Rejection of Claims 1-21, 23-52, and 57-65 under 35 U.S.C. §103(a)

Applicant respectfully traverses the rejection of claims 1-21, 23-52, and 57-65 under 35 U.S.C. § 103(a) as unpatentable over Sarin in view of ProjectDash. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the

claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 calls for a combination including, for example, “displaying, on a display device, status information of procedures, wherein **at least one of the displayed procedures is marked to alert the user that the marked procedure requires attention**” (emphasis added). The Office conceded that Sarin does not teach these elements, but then relied upon ProjectDash as allegedly curing the deficiencies of Sarin. Final Office Action, p. 5. However, this is not correct.

Specifically, ProjectDash at best “display[s] the status of all projects” (ProjectDash, p. 2). In ProjectDash, no project is “marked” to alert the user and none of the status indicators indicates that a project requires attention. In view of this, ProjectDash still fails to teach or suggest, at least, “wherein **at least one of the procedures is marked to alert the user that the procedure requires attention**” as

recited in claim 1 (emphasis added), and thus does not compensate for the deficiencies of Sarin.

Moreover, independent claim 1, as proposed to be amended, calls for a combination including, for example, “receiving, by a processor, a user-entered command to link at least one of the procedures to at least one pre-existing procedure definition such that subsequent **modifications made to the linked procedure definition** are automatically **reflected in the linked procedure**” (emphases added). Sarin also fails to teach at least these elements.

The above-noted elements were previously recited in dependent claim 30, now proposed to be cancelled. The Final Office Action asserted that Sarin, at col. 10, ll. 36-63, teaches these elements (Final Office Action, p. 10). However, this is not correct.

Specifically, Sarin teaches “**revising actual instances** of the process definition during execution and then **generalizing** [the process definition] from an instance” (Sarin, col. 10, ll. 45-47, emphases added, see, also, col. 10, ll. 5-24). That is, even assuming, *arguendo*, that “process definition” and “instance” of Sarin could be reasonably argued to correspond to the claimed “pre-existing procedure definition” and “procedure,” modifications in Sarin are not “made to the pre-existing procedure definition” and then “automatically reflected in the linked procedure,” but in a reverse manner. Therefore, Sarin also fails to teach or suggest, at least, “subsequent **modifications made to the linked procedure definition** are automatically **reflected in the linked procedure**” as recited in claim 1 (emphases added). ProjectDash also fails

to teach or suggest these elements, and thus does not compensate for the deficiencies of Sarin.

Therefore, the Office has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 1. Thus, no reason has been clearly articulated as to why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1, and thus claim 1 is allowable.

Independent claims 31, 42, and 57, although different in scope from independent claim 1, recite elements similar to that noted above for independent claim 1. As such, for reasons similar to that discussed above with respect to independent claim 1, Sarin and ProjectDash fail to render independent claims 31, 42, and 57 obvious, and these claims are, therefore, allowable.

Dependent claims 2-21, 23-29, 32-52, and 58-65 are also allowable at least by virtue of their dependence from independent claim 1, 31, 42, or 57. Claim 30 is proposed to be cancelled, rendering its rejection moot.

Moreover, with respect to claim 7, the Office asserted that Sarin teaches the claimed elements of “introducing rules and pre-configuring ad-hoc coordination patterns to handle exceptions and dependencies within actions.” Final Office Action, p. 7. This is not correct.

Sarin teaches copying a process during generalizing description of a workflow process, and “when [the] process is so copied, the interrelationships between the

various task objects ... are retained.” Sarin, col. 7, l. 47 - col. 8, l. 2. However, in Sarin, there are no “rules” and “patterns” introduced to handle “exceptions” and “dependencies,” as recited in claim 7. ProjectDash also fails to teach these elements, and thus does not compensate for the deficiencies of Sarin.

With respect to claim 12, the Office asserted that Sarin teaches the claimed elements that “actions are grouped into phases.” Final Office Action, p. 7. This is not correct.

Sarin teaches a life cycle of process instance, which is a description of “the **behavior** of process instances” (Sarin, col. 6, ll. 29-30, emphasis added), and includes different stages, such as instantiation, assignment, enactment, and completion (Sarin, col. 6, ll. 32-45). There is no teaching in Sarin to **group** tasks in a process **into phases**, as required by claim 12. ProjectDash also fails to teach these elements, and thus does not compensate for the deficiencies of Sarin.

With respect to claim 24, the Office asserted that Sarin teaches the claimed elements of “specifying whether an action is optional, mandatory or protected,” alleging that “permissions” in Sarin indicate protection. Final Office Action, p. 9. This is not correct.

The “permissions” in Sarin are to “empower[] certain people ... to **create new task objects**” (Sarin, col. 9, ll. 64-67, emphasis added), but not to indicate an action is “protected.” There is no teaching in Sarin to “specify[] whether an action is optional, mandatory or protected,” as recited in claim 24. ProjectDash also fails to teach these elements, and thus does not compensate for the deficiencies of Sarin.

In view of the above additional reasons, claims 7, 12, and 24 are allowable.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-21, 23-52, and 57-65 under 35 U.S.C. § 103(a).

IV. Official Notice

The Office appeared to take Official Notice with respect to elements of claim 29, stating that “it is old and well known to employ template wizards that enable a user to more accurately complete a template.” Final Office Action, p. 10.

Applicant respectfully traverses the Office’s apparent reliance on personal knowledge by Official Notice. M.P.E.P. § 2144.03(C) states “[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding” (emphases added). Further, M.P.E.P. § 2144.03(A) states, “[o]fficial notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances . . . [o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” Because the Office appears to be asserting Official Notice based on personal knowledge, Applicant requests that the Office provide documentary evidence as required by the M.P.E.P. Moreover, Applicant respectfully submits that it is not well-known or common knowledge in the art to employ template wizards that enable a user to more accurately complete a template.

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-21, 23-29, 31-52, and 57-65 in condition for allowance. Applicant submits that the proposed amendments to claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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